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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS,
WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>25 June 2008</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-20</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-20</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1. ☐ Certified copies of the priority documents have been received.

   2. ☐ Certified copies of the priority documents have been received in Application No. _____.

   3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-20 are pending in this application and presented for examination.

Continued Examination Under 37 CFR 1.114

2.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible

for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been

timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR

1.114. Applicant's submission filed on 6/25/08 has been entered.

Response to Arguments

3.   Applicant's arguments filed 6/25/08, with respect to the 35 U.S.C. 112, first paragraph

rejections of claims 1-9 and 13, have been fully considered but they are not persuasive.

4.   As to claim 1, Applicant argues the negative limitation has been transformed into a

positive limitation and that there are numerous examples in the specification supporting the

language. The Examiner fails to see how the new language differentiates itself from the language

previously used. The limitation still falls into the category of a negative limitation, as nothing in

the specification supports the exclusion of a mobile phone number. Applicant points to none of

the supposed examples in the specification and Examiner cannot find any support for the current

and previous language.

5.   As to claims 4 and 13, Applicant alleges there are numerous examples in the specification

to support the relevant language, but provides none of these supposed examples and Examiner

cannot find any.

6.   Applicant's arguments, see page 10, filed 6/25/08, with respect to the 35 U.S.C. 112,

second paragraph rejections of claims 1-9, have been fully considered and are persuasive. The

35 U.S.C. 112, second paragraph rejections of claims 1-9 have been withdrawn.

7.   Applicant's arguments filed 6/25/08, with respect to the 35 U.S.C. 103 rejections of the

claims, have been fully considered but they are not persuasive.

8.   As to claim 1, Applicant argues the device identifiers are not dynamically created as they

are drawn from a pre-existing pool. The Examiner has previously shown that the Applicant's

invention also draws from a pre-existing pool of "a set number of decimal or hexadecimal

numbers, or even a set number of characters and/or numbers" (see page 6, paragraph 17 of the

previous Office Action mailed on 3/25/08). Therefore, 35 U.S.C. 112, first paragraph (new

matter) issues are raised by the amended limitation.

        Applicant additionally argues the amended limitation of "always associated with a same

device." This also raises new matter issues, as Applicant's own specification explicitly goes

against this limitation. The specification recites reusing device identifiers for a plurality of

devices if a time out occurs (Page 11, [0032], ln. 7-10).

Applicant's remaining arguments are addressed to the negative limitation of excluding

mobile phone numbers as well as the negative limitation of excluding the manufacturer as the

device type. The limitations are properly addressed below under 35 U.S.C. 112, first paragraph.

Claim Rejections - 35 USC § 112

9.　　　The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making
> and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it
> pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode
> contemplated by the inventor of carrying out his invention.

10.　　　Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with

the written description requirement. The claim(s) contains subject matter which was not

described in the specification in such a way as to reasonably convey to one skilled in the relevant

art that the inventor(s), at the time the application was filed, had possession of the claimed

invention.

11.　　　As to claim 1, excluding the mobile phone number as a device identifier is a negative

limitation that appears to have no support in the specification [see MPEP 2173.05(i), Negative

Limitations].

Additionally, the phrase "dynamically created" is not supported by the specification. The

Examiner has previously shown that the Applicant's invention draws from a pre-existing pool of

"a set number of decimal or hexadecimal numbers, or even a set number of characters and/or

numbers" (see page 6, paragraph 17 of the previous Office Action mailed on 3/25/08).

Furthermore, the amended limitation of "always associated with a same device" raises

new matter issues, as Applicant's own specification explicitly goes against this limitation. The

specification recites reusing device identifiers for a plurality of devices if a time out occurs (Page

11, [0032], ln. 7-10).

12.   As to claims 4 and 13, the device type not indicating the manufacturer is a negative

limitation that appears to have no support in the specification [see MPEP 2173.05(i), Negative

Limitations].

13.   As to claims 10, 15, and 18, the claims are rejected using rationale similar to claim 1

above (with respect to the limitation of "always associated with a same device").

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

15.   Claims 1-2, 9-11, 14-16, and 18-20 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Okano et al. (Okano), U.S. Publication No. 2002/0062485 A1, in view of

Aoyama et al. (Aoyama), U.S. Publication No. 2003/0199265 A1.

16.   As to claim 1, Okano discloses a method for assigning a device identifier to a device

(Abstract), the method comprising:

receiving a request for the device identifier at a server ([0084], ln. 1-5; [0088], ln. 1-4);

obtaining the device identifier ([0092]; temporarily allocated IP addresses are set), the

device identifier being unique from device identifiers of other devices of the server ([0170];

duplicate IP addresses are prevented), that is dynamically allocated by the server in response to a

request ([0002], DHCP is short for Dynamic Host Configuration Protocol, "dynamically allocate

an IP address"; [0092]; [0170]; DHCP dynamically allocates one of any number of IP addresses

from a pool and prevents duplicate addresses; the mere existence of a pool does not mean the

allocation of the device identifier is not dynamic, static simply means a set device identifier is

assigned to one device; rather, the allocation is dynamic, in that any of the identifiers from the

pool may be assigned, may be revoked if found to be a duplicate or rejected by the client, and

assignment is based on a lease time as opposed to statically set permanently; clearly the fact that

DHCP is called **Dynamic** Host Configuration Protocol, DHCP being an extremely well known

protocol, makes it clear that the definition of dynamic as interpreted by the examiner is in line

with the interpretations of those of ordinary skill in the art);

marking a status of the device identifier as pending ([0092]; the IP addresses are set as

temporarily allocated, which is marking the device identifiers as pending);

sending the device identifier to the device ([0098]);

marking the status of the device identifier as in use after receiving an acknowledgment

from the device ([0099]; [0102]); and

sending a confirmation to the device after the acknowledgment is received ([0102];

[0110]).

Okano is silent on the device identifier being unrelated to a network address or host name

of the device; and

the device is a wireless device that does not have a readily accessible device identifier or

other communications related information.

However, Aoyama discloses the device identifier being unrelated to a network address or

host name of the device ([0094]); and

the device is a wireless device that does not have a readily accessible device identifier or

other communications related information ([0094]).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to modify the teachings of Okano by obtaining a device identifier other than a network address or

host name for a wireless device as taught by Aoyama in order to obtain a device identifier, such

as a mobile phone number, to enable communications (Aoyama: [0094]).

17.   As to claim 2, Okano and Aoyama disclose the invention substantially as in parent claim

1, including receiving a second acknowledgment from the device (Okano: [0110]-[0111];

[0149]-[0151]; it is inherent in and a standard feature of DHCP, which is taught by Okano, that a

second acknowledgement is sent from a device to renew its lease); and

sending a second confirmation to the device (Okano: [0102]; [0110]-[0111]; [0147]-

[0151]; it is inherent in and a standard feature of DHCP, which is taught by Okano, that a server

sends a confirmation to renewal requests in the form of a DHCPACK message to extend a device's lease).

18.   As to claim 9, Okano and Aoyama disclose the invention substantially as in parent claim 1, including reusing the device identifier for another request received from another device after a time out period has elapsed (Okano: [0200]); and

sending a rejection to the device if the acknowledgment is received after the time out period has elapsed (Okano: [0200]; the timed out subscriber terminal is disabled to use the IP address, which is a rejection).

19.   As to claim 10, Okano discloses a method of obtaining a device identifier for a device (Abstract), the method comprising:

sending a request for the device identifier to a server ([0084], ln. 1-5; [0088], ln. 1-4), the device identifier being unique from device identifiers of other devices of the server ([0170]);

sending an acknowledgment to the server after receiving the device identifier from the server ([0092]; [0098]-[0099]; [0102]; an acknowledgement is sent to the server in the form of a DHCP request packet); and

using the device identifier after receiving a confirmation from the server ([0102]; [0110]-[0111]).

Okano is silent on the device identifier being unrelated to a network address or host name of the device; and

the device is a wireless device that does not have a readily accessible device identifier or other communications related information.

However, Aoyama discloses the device identifier being unrelated to a network address or host name of the device ([0094]); and

the device is a wireless device that does not have a readily accessible device identifier or other communications related information ([0094]).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Okano by obtaining a device identifier other than a network address or host name for a wireless device as taught by Aoyama in order to obtain a device identifier, such as a mobile phone number, to enable communications (Aoyama: [0094]).

20.   As to claim 11, Okano and Aoyama disclose the invention substantially as in parent claim 10, including a timestamp is also received from the server, and wherein the acknowledgment includes the device identifier and the timestamp (Okano: [0092]; [0110]-[0111]; a lease time is set, which is a timestamp).

21.   As to claim 14, Okano and Aoyama disclose the invention substantially as in parent claim 10, including sending a second acknowledgment to the server if the confirmation has not been received after a time out period (Okano: Abstract; it is inherent in and a standard feature of DHCP, which is taught by Okano, that a second acknowledgement is sent to the server after a time out period).

22.   As to claims 15 and 18, the claims are rejected for the same reasons as claim 1 above.

23.   As to claims 16 and 19, the claims are rejected for the same reasons as claim 10 above.

24.   As to claim 20, the claim is rejected for the same reasons as claim 9 above.

25.   Claims 3-7, 12-13, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Okano and Aoyama as applied to claims 1, 10, and 15 above, in view of Matsuda et al.

(Matsuda), U.S. Publication No. 2002/0133573 A1, and with Poger et al. (Poger), U.S. Patent

No. 6,772,420 B1, providing intrinsic evidence for claims 4 and 13.

26.   As to claim 3, Okano and Aoyama disclose the invention substantially as in parent claim

1, but are silent on managing a set of device entries at the server, wherein each of the set of

device entries includes a device identifier, a status, and correlation data, and wherein the request

includes correlation data for the device.

        However, Matsuda does disclose managing a set of device entries at the server ([0064],

ln. 1-4),

        wherein each of the set of device entries includes a device identifier, a status, and

correlation data ([0064]; a MAC address and an IP address are device identifiers; a name_in_use

code is a status; a host name is correlation data), and

        wherein the request includes correlation data for the device ([0065], ln. 1-7; a host name

is included in the request for configuration of the device).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to modify the teachings of Okano and Aoyama by managing a set of device entries at a server,

the device entries including a device identifier, a status, and correlation data and by including

correlation data for a device in a request as taught by Matsuda in order to provide automatic

configuration services for unadministered networks while being automatically adaptable within

administered environments (Matsuda, Abstract, ln. 4-7), in order to enable a server to keep track

of a device's MAC address and corresponding host name and IP address (Matsuda, [0064]), and

in order to allow a client to suggest desired settings in a request (Matsuda, [0065], ln. 5-7).

27.   As to claims 4 and 13, Okano, Aoyama, and Matsuda disclose the invention substantially

as in parent claims 3 and 12, including the correlation data includes a device type and user data

(Matsuda: [0064]; [0065], ln. 1-7; a host name is user data; a MAC address associated with a

DHCP request is correlation data; it is inherent that a device type is included in the correlation

data as device type information is embedded in the MAC address, which is in turn embedded in

DHCP messages, see Poger, Col. 3, ln. 19-31 and Col. 4, ln. 48-55).

28.   As to claim 5, Okano, Aoyama, and Matsuda disclose the invention substantially as in

parent claim 3, including each of the set of device entries further includes a timestamp, the

method further comprising setting the timestamp when the status is marked as pending (Okano:

[0092]; temporarily allocated IP addresses are made and lease times are set, which is setting a

timestamp when the status is marked as pending).

29.   As to claim 6, Okano and Aoyama disclose the invention substantially as in parent claim

1, but are silent on providing correlation data at the server;

       generating at least one device identifier based on the correlation data before the request is

received;

       marking the status of the generated at least one identifier as unused; and

       locating one of the at least one device identifier having a status marked as unused after

the request is received using the correlation data for the at least one device identifier and

correlation data in the request.

       However, Matsuda does disclose providing correlation data at the server ([0077]-[0078];

a preset address range is associated with clients requesting IP addresses from the DHCP server,

wherein the preset address range at the DHCP server is correlation data at the server);

       generating at least one device identifier based on the correlation data before the request is

received ([0077]-[0078]; [0079], ln. 1-3; a maximum of 100 addresses is generated based on the

preset address range);

       marking the status of the generated at least one identifier as unused (Fig. 7, item 720);

and

       locating one of the at least one device identifier having a status marked as unused after

the request is received using the correlation data for the at least one device identifier and

correlation data in the request (Fig. 7, items 704, 706, 708, and 720; [0065]; [0077]-[0078]; an IP

address that is not in use is located after the request is received; the preset address range for the

device identifier and the MAC address, desired IP address, and desired host name in the request

are used to configure the device, which is correlation data for the device identifier and

correlation data in the request).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to modify the teachings of Okano and Aoyama by providing correlation data at a server,

generating device identifiers based on the correlation data before a request is received, marking

the device identifiers as unused, and locating an unused device identifier using correlation data

for the device identifier and correlation data in the request after the request is received as taught

by Matsuda in order to define a range of available client addresses (Matsuda, [0077]), in order to

allocate those client addresses (Matsuda, [0077]), in order to define the addresses that the DHCP

server can assign (Matsuda, [0079], ln. 1-3), and in order to allow a client to suggest a desired IP

address and ascertain if the IP address is suitable (Matsuda, [0065], ln. 5-7 and 36-38).

30.   As to claim 7, Okano and Aoyama disclose the invention substantially as in parent claim

1, but are silent on generating a device identifier after receiving the request using correlation data

in the request.

However, Matsuda does disclose generating a device identifier after receiving the request

using correlation data in the request (Fig. 7, items 704, 706, and 708; [0065]; a device identifier

is generated using the MAC address, desired IP address, and desired host name in the request,

which is correlation data in the request).

It would have been obvious to one of ordinary skill in the art at the time of the invention

to modify the teachings of Okano and Aoyama by generating a device identifier after receiving a

request using correlation data in the request as taught by Matsuda in order to allow a client to

suggest desired settings in a request (Matsuda, [0065], ln. 5-7).

31.   As to claim 12, Okano and Aoyama disclose the invention substantially as in parent claim

10, but are silent on the request includes correlation data.

        However, Matsuda does disclose the request includes correlation data ([0065], ln. 1-7; a

desired host name is included in the request, which is correlation data in the request).

        It would have been obvious to one of ordinary skill in the art at the time of the invention

to modify the teachings of Okano and Aoyama by including correlation data in a request as

taught by Matsuda in order to allow a client to suggest desired settings in a request (Matsuda,

[0065], ln. 5-7).

32.   As to claim 17, Okano and Aoyama disclose the invention substantially as in parent claim

15, but are silent on a management system for managing a set of device entries, wherein each of

the set of device entries includes a unique device identifier, a status, and correlation data,

wherein the request includes correlation data for the device; and

        a comparison system for obtaining one of the set of device entries based on correlation

data for the device.

        However, Matsuda does disclose a management system for managing a set of device

entries ([0064], ln. 1-4),

wherein each of the set of device entries includes a unique device identifier, a status, and correlation data ([0064]; a MAC address and IP address are unique device identifiers; a name_in_use code is a status; a host name is correlation data),

wherein the request includes correlation data for the device ([0065], ln. 1-7; a host name is included in the request for configuration of the device); and

a comparison system for obtaining one of the set of device entries based on correlation data for the device (Fig. 7, items 704, 706, and 708; [0065]; the desired IP address in the request is used to obtain an IP address, which is correlation data for the device).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Okano and Aoyama by managing a set of device entries at a management system, the device entries including a unique device identifier, a status, and correlation data and by including correlation data for a device in a request as taught by Matsuda in order to provide automatic configuration services for unadministered networks while being automatically adaptable within administered environments (Matsuda, Abstract, ln. 4-7), in order to enable a management system to keep track of a device's MAC address and corresponding host name and IP address (Matsuda, [0064]), in order to allow a client to suggest desired settings in a request to obtain an IP address (Matsuda, [0065], ln. 5-7), and in order to obtain an IP address so that a device may communicate across an IP network or networks.

33.   Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Okano and Aoyama as applied to claim 1 above, in view of Meier, U.S. Patent No. 7,096,273 B1.

34.   As to claim 8, Okano and Aoyama disclose the invention substantially as in parent claim

1, but are silent on marking the status of the device identifier as unused if the acknowledgment is

not received after a time out period.

        However, Meier does disclose marking the status of the device identifier as unused if the

acknowledgment is not received after a time out period (Col. 2, ln. 8-15).

        It would have been obvious to one of ordinary skill in the art at the time of the invention

to modify the teachings of Okano and Aoyama by marking a device identifier as unused if an

acknowledgement is not received after a time out period as taught by Meier in order to put the

device identifier back into a pool ready to be re-used (Meier, Col. 2, ln. 13-15).

                                    Conclusion

35.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Brian P. Whipple whose telephone number is (571)270-1244.

The examiner can normally be reached on Mon-Fri (9:30 AM to 6:00 PM EST).

        If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

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information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian P. Whipple
/B. P. W./
Examiner, Art Unit 2152
8/13/08

/Bunjob Jaroenchonwanit/

Supervisory Patent Examiner, Art Unit 2152